



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/590,091	08/21/2006	Harald Hoepfner	82577	4155
23685 7590 03/11/2010 KRIEGSMAN & KRIEGSMAN 30 TURNPIKE ROAD, SUITE 9 SOUTHBOROUGH, MA 01772				
EXAMINER				
LEWIS, JUSTIN V				
ART UNIT		PAPER NUMBER		
3725				
MAIL DATE		DELIVERY MODE		
03/11/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/590,091

Applicant(s)

HOEPPNER ET AL.

Examiner

JUSTIN V. LEWIS

Art Unit

3725

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3-5 and 7-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-5, 7-14, 18 and 20-25 is/are rejected.
- 7) ☒ Claim(s) 15-17 and 19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 11 December 2009
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Applicants' amendment, filed on 09 December 2009, is acknowledged. Amended claims 1, 3, 8, 12-15 and 22 are acknowledged. Accordingly, claims 1, 3-5 and 7-25 are currently pending.

Allowable Subject Matter

2. Claims 15-17 and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Regarding claim 15-17 and 19, the prior art, neither alone nor in combination with International Publication No. WO 98/19870 to Almgren ("Almgren") and U.S. Patent No. 4,828,636 to Rausing ("Rausing") renders obvious the combination of limitations found in dependent claims 15-17 and 19, specifically wherein said limitations include transponder unit/chip module and integrated antenna assemblies which are applied to the substrate document by a tape automatic bonding process or casting compound, and IC's fastened on contact elements by means of flip chip technology, and no motivation is found to modify U.S. Patent No. 7,360,712 to Trantoul et al. ("Trantoul") to obtain said claimed limitation. To modify Trantoul in such a manner as to obtain the claimed limitation would require the use of improper hindsight, as Trantoul provides no suggestion of a need for such modifications, and the modification of a secondary reference would be necessary.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1, 4-5, 9-11, 13-14, 18 and 21-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 7,360,712 to Trantoul et al. ("Trantoul") in view of International Publication No. WO 98/19870 to Almgren, et al. ("Almgren").

Regarding claim 1, Trantoul discloses a method for the production of a book-type security document (see col. 3, lines 18-21) having a book cover on an outside of the book-type security document (see fig. 7), which is reinforced (see col. 5, lines 36-42), and having at least one security cambric (sheet 25) and at least one transponder unit (microtransponder 7), said method comprising the steps of: i) applying at least one first laminated layer (security film 3, antenna film 30) on at least one side of the at least one

security cambric and on at least one side of the at least one transponder unit (see fig. 5) and applying at least one second laminated layer on at least an opposite side of the at least one security cambric (see fig. 5), wherein the at least one security cambric and the at least one transponder unit are fully encompassed by the laminated layers and a circumferential, closed edge is provided by the laminated layers and whereby a laminated layer sheath is formed (see col. 12, lines 10-15); and ii) introducing the laminated layer sheath into a book block (see fig. 7), a projection being produced on at least one longitudinal side of the laminated layer sheath (see col. 12, lines 10-15), but fails to disclose the step of sewing the laminated layer sheath into the book block in the area of the projection.

Almgren teaches the concept of sewing a laminated layer sheath into a book block in the area of a projection (see pg. 2, lines 5-7).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to sew each page into the Trantoul passport in the manner taught by Amgren in order to attach said pages to the cover, as explicitly taught by Almgren (see pg. 2, lines 5-7).

Regarding claim 4, Trantoul in view of Amgren discloses the method according to claim 1, characterized in that the at least one security cambric and the at least one transponder unit are combined in one layer or that a composite is formed by several layers (see Trantoul fig. 5).

Regarding claim 5, Trantoul in view of Amgren discloses the method according to claim 1, characterized in that at least one transponder unit is applied onto the at least

one security cambric, and a composite is formed which is encompassed by the laminated layers (see Trantoul fig. 5).

Regarding claim 9, Trantoul in view of Amgren discloses the method according to claim 1, characterized in that the laminated layers are glued, pressed, welded or combined with each other at least under pressure or temperature (see Trantoul col. 12, lines 10-15).

Regarding claim 10, Trantoul in view of Amgren discloses the method according to claim 1, characterized in that the at least one transponder unit is personalized after the production of the laminated layer sheath (see Trantoul col. 7, lines 64-67 and col. 8, lines 1-5).

Regarding claim 11, Trantoul in view of Amgren discloses the method according to claim 1, characterized in that the at least one transponder unit is personalized with an algorithm forming a hash value on the basis of the ICAO line and/or of personalization data (see Trantoul col. 7, lines 64-67 and col. 8, lines 1-5).

Regarding claim 13, Trantoul in view of Amgren discloses the method according to claim 1, characterized in that, during or after the production of a security document, a value permanently deposited in the at least one transponder unit is introduced as a security characteristic (see Trantoul col. 7, lines 58-67- note that Examiner considers any information provided thereon to be a security characteristic).

Regarding claim 14, Trantoul in view of Amgren discloses the method according to claim 1, characterized in that the laminated layers are produced of plastic films selected from the group consisting of PVC, ABS, PET-G, PET, PE, PP, PA, teslin, PC,

and of sandwich-type film combinations of the aforementioned materials (see Trantoul col. 9, lines 17-19).

Regarding claim 18, Trantoul in view of Amgren discloses method according to claim 16, characterized in that the at least one transponder unit comprises a chip module for contacting an external coil or antenna (see col. 3, lines 25-39), with the coil or antenna being produced through screen printing by means of polymer and conductive pastes, through enamel-insulated metallic wires, especially by means of ultrasonic sonotrode laying technique, through insertion or lamination of an air coil into corresponding recesses, through flexible printed circuit boards in subtractive technique, through an etching technique in metallic surfaces or through an inkjet technique with a conductive medium (see Trantoul col. 10, lines 1-7).

Regarding claim 21, Trantoul in view of Amgren discloses the method according to claim 1, characterized in that the at least one laminated layer is processed as a transparent film for the production of the laminated layer sheath (see Trantoul col. 9, lines 15-17 and col. 12, lines 10-15).

Regarding claim 22, Trantoul, as modified by Amgren (in the manner set forth in the rejection of claim 1, above), discloses a book-type security document (Trantoul passport) having a book cover on an outer side of the security document, which is reinforced with at least one security cambric (Trantoul sheet 25) and at least one transponder unit (Trantoul microtransponder 7) which are fully encompassed by at least one first and at least one second laminated layer (Trantoul security film 3, Trantoul thin film 30), forming a laminated layer sheath (Trantoul col. 12, lines 10-15) wherein the

laminated layer sheath is introduced into a book block (see Trantoul fig. 7) and a projection is produced on at least one longitudinal side of the laminated layer sheath (see Trantoul col. 12, lines 10-15) and that the laminated layer sheath is sewn into a book block in the area of the projection (see the combination set forth in the rejection of claim 1, above).

Regarding claim 23, Trantoul in view of Amgren discloses the security document according to claim 22, characterized in that the at least one security cambric and the at least one transponder unit are each designed smaller than or equal to an end format of a page of a book block (see Trantoul fig. 7).

Regarding claim 24, Trantoul in view of Amgren discloses the security document according to claim 22, characterized in that the at least one security cambric is designed as an inside page or a personalization page for a book block or as an end page (see Trantoul col. 11, lines 8-14).

Regarding claim 25, Trantoul in view of Amgren discloses the book-type security document according to claim 22, characterized in that the at least one laminated layer is designed as a cover film or as an overlay film (see Trantoul fig. 3, and col. 12, lines 10-15).

6. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Trantoul in view of Amgren and further in view of U.S. Patent No. 4,828,636 to Rausing ("Rausing").

Regarding claim 3, Trantoul in view of Amgren discloses the method according to claim 1, but fails to disclose the step of stamping the edges to an end format, cutting the edges, or cutting the edges to size by laser cutting.

Rausing teaches the concept of cutting the edges of pages within a booklet (see col. 4, lines 62-65).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to trim the edges of the booklet of Trantoul in view of Amgren in order to provide a better aesthetic appearance, as implicitly taught by Rausing (see col. 4, lines 62-65).

7. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Trantoul in view of Amgren and further in view of U.S. Patent No. 5,590,912 to Stevens ("Stevens").

Regarding claim 7, Trantoul in view of Amgren discloses the method according to claim 1, but fails to disclose a double page for a book block being formed by the laminated layer sheath and on one side of the double page, at least one security cambric being introduced and on the adjacent side of the double page, at least one transponder unit being introduced.

Stevens teaches the concept of providing a double page for a book block (see figs. 4-6, first envelope portion 126 and flap portion 127).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to use the Stevens double page teachings with the Trauntoul sheath in

order to provide the Trantoul book with a personalized insert, as explicitly taught by Stevens (see col. 4, lines 51-52).

Regarding claim 8, Trantoul in view of Amgren and further in view of Stevens discloses the method according to claim 7, characterized in that in a folding area of the double page: a stay, a groove or a perforation is formed, and the double page is sewn into a book block in the area of the stay, the groove or the perforation (see the combination set forth in the rejection of claim 7, above).

8. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Trantoul in view of Amgren and further in view of U.S. Patent No. 6,135,503 to Lob et al. ("Lob").

Regarding claim 12, Trantoul in view of Amgren discloses the method according to claim 1, but fails to disclose the step of providing at least one security characteristic in the laminated layer sheath after the production of said laminated layer sheath.

Lob teaches the concept of providing at least one security characteristic in a laminated layer sheath after the production of said laminated layer sheath (see col. 4, lines 15-28; providing information laser inscribed into a laminated data sheet).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to use the laser inscribed characteristic of Lob with the sheath of Trantoul in order to provide additional security to the document, as implicitly taught by Lob (see col. 4, lines 24-27).

9. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Trantoul in view of Amgren and further in view of U.S. Patent No. 5,528,222 to Moskowitz et al. ("Moskowitz").

Regarding claim 20, Trantoul in view of Amgren discloses the method according to claim 1, but fails to disclose a chip module with integrated antenna being directly applied on a security cambric and the thickness of the at least one laminated layer being locally thinned or punched out in the area of the chip module.

Moskowitz teaches the concept of providing a chip module with integrated antenna being directly applied on a security cambric and the thickness of at least one laminated layer being locally thinned or punched out in the area of the chip module (see col. 5, lines 8-20).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to use Moskowitz recess with the Trantoul substrate in order to reduce the thickness of the assembly, as explicitly taught by Moskowitz (see col. 5, lines 10-11).

Response to Arguments

In response to Applicants' argument that the Trantoul composite comprising the security film, the support film, and, in between, the passport sheet is, in contrast to the present invention, not laminated (see Applicants' Arguments/Remarks pg. 15, lines 12-14), Examiner respectfully asserts that as provided above and shown in Trantoul fig. 5, the composite is indeed laminated.

In response to Applicants' argument that Trantoul only discloses printing and adhesive bonding procedures for connecting the security film, the sheet and the support film, contrary to the present invention, in which a laminating procedure is claimed, which lamination comprises using pressure and temperature for building the layer sheath (see Applicants' Arguments/Remarks pg. 16, lines 4-7), Examiner respectfully asserts that

when laminated in the fashion set forth in the rejection above and in Trantoul fig. 5, at least minimal amounts of one of pressure and heat must be applied in order to secure the films to the sheets.

In response to Applicants' argument that the construction of the Almgren booklet differs from the book-type security document of the present invention because the booklet according to Almgren discloses the sewing of all pages (see Applicants' Arguments/Remarks pg. 19, lines 3-7), Examiner respectfully asserts that both Trantoul and Amgren concern security documents in the form of passport booklets.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JUSTIN V. LEWIS whose telephone number is (571)270-5052. The examiner can normally be reached on M-F 7:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dana Ross can be reached on (571) 272-4480. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dana Ross/
Supervisory Patent Examiner, Art Unit 3725
/JVL/